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10/701,039	11/04/2003	Peter Worthington Hamilton	5922R2CCC	6157

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EXAMINER

CHANG, VICTOR S

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 08/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/701,039

Applicant(s)

HAMILTON ET AL.

Examiner

Victor S. Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/26/04</u> . | 6) <input type="checkbox"/> Other: ____  |

## DETAILED ACTION

### *Specification*

1. The disclosure is objected to because of the following informalities:

In claim 1, the limitation "no reinforcing or supporting elements" is not described anywhere in the specification.

Also, in claim 20, the limitation "said second sheet of material is a release liner" is not described anywhere in the specification.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. How the protrusions are "integral" with the sheet material and also being "removable", "repositionable" and "frangible" are critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

More particularly, in claim 1, in the absence of structural and/or compositional limitations, the property recitations that the protrusions are "integral" with the sheet material and also being "removable", "repositionable" and "frangible" are considered to

be too broad and in excess of provided enablement in the specification, since the property recitation purports to cover any conceivable combination of structures and/or compositions either presently existing or which might be discovered in future and which would impart desired characteristics, but are unobvious to the instantly claimed invention, and the recitations also appear to read upon materials that could not possibly be used to form the contemplated genus or subgenus of articles. As a result, undue experimentation would be required to formulate suitable compositions for this claim or to determine what would or would not infringe. *Ex parte Slob* (PO BdApp) 157 USPQ 172.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, in claim 1, in the absence of structural and/or compositional limitations, the property recitations that the protrusions are "integral" with the sheet material and also being "removable", "repositionable" and "frangible" are vague, indefinite, functional, and fails to give notice as to what constitutes infringement upon the instantly claimed invention. It should be noted that claims merely setting forth physical characteristics desired in article, and not setting forth specific structure and/or compositions which would meet such characteristics, either in the claim or specification, are invalid as vague, indefinite, and functional, since it recites compounds by what it is desired that they do rather than what they are, and resulting in a claim scope that is

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indefinite since one of skill in the art is unable to determine without undue experimentation what compounds are included or excluded therefrom. As such, it is unclear as to what is the scope of the invention of which Applicant intends to claim. *Ex parte Slob* (PO BdApp) 157 USPQ 172.

Additionally, in claim 1, the limitation "protrusions comprising from about 30% to about 70% of said first active side" is vague and indefinite, because it is not clear what it is related to. Does it mean percentage of surface area, weight, or else? Clarification is requested.

### ***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claim 20 is rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility.

Specifically, in addition to the silence of the specification regarding a release liner disposed upon the surface of second adhesive, as set forth above, the specification, in the contrary, expressly discloses that the instant invention does not need a release liner (see specification, page 7, lines 14-16). As such, it appears the presence of a release liner is unnecessary, and lacks patentable utility.

### ***Double Patenting***

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8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1, 2, 4, 6, 7, 13, 16 and 17 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 5, 7, 8, 14, 16, 17, 19 and 24 of U.S. Patent No. 6,194,062. Although the conflicting claims are not identical, they are not patentably distinct from each other, because they are directed to the same subject matter (a pressure sensitive adhesive sheet having protrusions), and for the same application (storage wrap). As such, in the absence of evidence to the contrary, it is the Examiner's position that a suitable amount of surface coverage by deformable protrusions on the pressure sensitive adhesive sheet, for preventing premature adhesion, is either anticipated, or obviously provided once the produce is made.

10. Claims 1, 2, 4, 6, 7, 13, 16 and 17 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 4, 7, 8 and 9 of U.S. Patent No. 6,818,292. Although the conflicting claims are not identical, they are not patentably distinct from each other, because they are directed to

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the same subject matter (a pressure sensitive adhesive sheet having protrusions), and for the same application (storage wrap). As such, in the absence of evidence to the contrary, it is the Examiner's position that a suitable amount of surface coverage by deformable protrusions on the pressure sensitive adhesive sheet, for preventing premature adhesion, is either anticipated, or obviously provided once the produce is made.

**11.** Claims 1, 2, 4, 6, 7, 13, 16 and 17 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 9, 10, 14, 15, 18, 41, 50, 52, 55, 58, 66, 95, 97, 98, 100, 101, 105, 106 and 108 of copending Application No. 09/715,586. Although the conflicting claims are not identical, they are not patentably distinct from each other, because they are directed to the same subject matter (a pressure sensitive adhesive sheet having protrusions), and for the same application (storage wrap). As such, in the absence of evidence to the contrary, it is the Examiner's position that a suitable amount of surface coverage by deformable protrusions on the pressure sensitive adhesive sheet, for preventing premature adhesion, is either anticipated, or obviously provided once the produce is made.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

**12.** Claims 1, 2, 4, 6, 7, 13, 16 and 17 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3, 4, 10, 12-14, 17, 38-41, 47, 49-51, 53, 54, 86-89, 97-99 and 102 of copending

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Application No. 09/716,740. Although the conflicting claims are not identical, they are not patentably distinct from each other, because they are directed to the same subject matter (a pressure sensitive adhesive sheet having protrusions), and for the same application (storage wrap). As such, in the absence of evidence to the contrary, it is the Examiner's position that a suitable amount of surface coverage by deformable protrusions on the pressure sensitive adhesive sheet, for preventing premature adhesion, is either anticipated, or obviously provided once the produce is made.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

**13.** Claims 1, 2, 4, 6, 7, 13, 16 and 17 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 7, 10, 16 of copending Application No. 10/003,900. Although the conflicting claims are not identical, they are not patentably distinct from each other, because they are directed to the same subject matter (a pressure sensitive adhesive sheet having protrusions), and for the same application (storage wrap). As such, in the absence of evidence to the contrary, it is the Examiner's position that a suitable amount of surface coverage by deformable protrusions on the pressure sensitive adhesive sheet, for preventing premature adhesion, is either anticipated, or obviously provided once the produce is made.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.



***Claim Rejections - 35 USC § 102***

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

***Claim Rejections - 35 USC § 103***

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 1, 2, 4-9 and 11-17 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Wilbur (US 2338749).

Wilbur's invention relates to wrappers of flexible paper or other equivalent sheet material (column 1, lines 1-3). Wilbur teaches that the invention can be embodied in a label, wrapper, envelope or other article of flexible sheet material intended for other uses (page 1, column 2, lines 34-37). Fig. 7 shows that an embodiment in which a multiplicity of pin punctures 16 each of which is surrounded by an outstanding tubular burr 17, and surrounded by a coating of permanently sticky or tacky adhesive 18. The outstanding burrs 17 serve as means for normally shielding the adhesive coating against accidental contact with other objects. When end portions are overlapped and pressed together, the burrs or bosses 17 are collapsed, the ends are united by the adhesive (page 2, column 1, line 48 to column 2, line 8).

For claims 1, 2, 4-7 and 15-17, Wilbur is silent about the percent surface coverage of the protrusions. However, since Wilbur teaches the same subject matter (a flexible wrapper sheet material) and for the same application (wrapping and enveloping), in the absence of evidence to the contrary, it is the Examiner's position that a suitable surface coverage of the outstanding tubular burrs are either anticipated, or obviously provided by practicing the invention of prior art. It should be noted that where the claimed and prior art products are shown to be identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a *prima facie* case of either anticipation or obviousness has been established. See MPEP § 2112.01.

For claim 8, since Wilbur's adhesive layer is a continuous layer, it inherently forms a sealing engagement.

Similarly, for claims 9 and 11-14, while Wilbur is silent about adhesion peel force, the spatial relation between the outstanding tubular burrs, the height of burrs, the deformation resistance of the burrs, since Wilbur does teach the same subject matter (a flexible wrapper sheet material) and for the same application (wrapping and enveloping), in the absence of evidence to the contrary, it is the Examiner's position that the above-mentioned elements are also either anticipated, or obviously provided by practicing the invention of prior art.

17. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wilbur (US 2338749) in view of Reed et al. (US 4054697).

The teachings of Wilbur are again relied upon as set forth above.

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For claim 3, it is noted that Wilbur lacks a teaching that the protrusions comprise an amorphous pattern. However, it is noted that Reed's invention is directed to a sheet material which is provided with a continuous coating of tacky, pressure-sensitive, adhesive. The adhesive coating is then provided with a coating of a discontinuous layer of resilient, non-adhesive particles. The coating of particles have the ability to be deformed under a load and thus, upon application to a support surface, deform, under pressure, to such an extent as to bring the adhesive and the surface into fuller contact (Abstract). As such, in the absence of unexpected results, it would have been obvious to one of ordinary skill in the art to substitute Wilbur's outstanding tubular burrs with Reed's coating of protruded deformable particles, which inherently has an amorphous pattern. It should be noted that the selection and substitution of a known equivalent material based on its suitability for its intended use supported a *prima facie* obviousness determination. See MPEP § 2144.07.

18. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wilbur (US 2338749) in view of the admitted prior art.

The teachings of Wilbur are again relied upon as set forth above.

For claim 10, Wilbur lacks express teachings about the wrapper's physical properties as being conformable. However, it is noted that Applicants have admitted that it is known art that sheet materials with clinging character (i.e., cling film) can be used to form a closure for a container (i.e., conformable) (specification, page 1, lines 18-26). As such, in the absence of unexpected results, it would have been obvious to one of ordinary skill in the art to select a base sheet material which is conformable to a

container, motivated by the desire to be able to fully enveloping (wrapping) the container.

**19.** Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilbur (US 2338749) in view of Reed et al. (US 4054697) and Kovac (US 3819467).

The teachings of Wilbur and Reed are again relied upon as set forth above.

For claim 18, Wilbur lacks a teaching of coating adhesive on both sides of the sheet material. However, it is noted Kovac's invention teaches a double faced tape which seals to the inside of a wrapped frame (column 4, lines 4-9). As such, it would have been obvious to one of ordinary skill in the art to modify the teachings of Wilbur and Reed by coating adhesives on both sides of the wrapper, motivated by the desire to obtain a good seal around a wrapped container without loose film hanging away from the side of the container.

For claim 19, in the absence of distinct structural and/or compositional limitation, the instantly claimed second sheet of material fails to preclude the combined teachings of Wilbur in view of Reed and Kovac, as set forth above.

### ***Conclusion***

**20.** Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S. Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H. Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Victor S Chang  
Examiner  
Art Unit 1771

8/4/05